

Appln. No.: 10/021,426
Amendment Dated November 4, 2004
Reply to Office Action of August 12, 2004

MATP-607US

Remarks/Arguments:

The drawing was objected with regard to Figure 2. It is clear from the surrounding text that the block 230 "DTMF DECODER" was in error and is amended to "DTMF DECODER" to correct this error.

Claims 1-18 are pending in the above identified application.

Claims 1, 3, 4, 6, 13, 15, 16 and 18 were rejected under 35 U.S.C. § 103 (a) as being obvious in view of Hashimoto et al. This ground for rejection is respectfully traversed. With regard to claim 1, Hashimoto et al. do not disclose or suggest:

A telecommunications unit that records and presents audio messages which include dual-tone multi-frequency (DTMF) tones, comprising:

...a processor that stores **combined messages**, which include the received audio messages of the text representation of the DTMF tones into **the storage device.**" (emphasis added).

As described in response to the previous Office Action, the incoming message in Hashimoto et al. is stored in the ICM unit 13 (col. 2, lines 66-67), while the data corresponding to the DTMF tones is stored in the memory 16. (col. 3, lines 4-6). Because the subject application, as defined by claim 1, stores the incoming audio message and the text corresponding to the DTMF tones as a single combined message on a single storage device, the subject invention is not obvious in view of Hashimoto et al.

The Office action states that although Hashimoto et al. do not explicitly disclose an ICM unit and memory integrated as one unit, it would have been obvious to modify Hashimoto et al. to incorporate the ICM unit and memory into a single device. The applicants respectfully disagree. Hashimoto et al. describes the ICM unit as "an incoming message recording unit which records messages from callers." (col. 2, lines 66-67). Hashimoto et al. disclose only separate recording of the incoming messages and the telephone number. Furthermore, Hashimoto et al. disclose separate uses for the recorded messages and the stored telephone numbers (see e.g. col. 4, lines 56-59, which states that the entered telephone number data is repeated back to the caller while the recorded message is not and col. 5, lines

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35-41 which states that the calling number data is sent to the portable telephone automatically while the user must request replay of the recorded message). In addition Hashimoto describe recording a message and leaving a number as alternatives. The number is left for urgent matters while for non-urgent matters, the user merely records a message. (See col. 4, lines 14-37). Thus, it would not have been obvious to incorporate a recording unit and memory into a single device. Furthermore, Hashimoto et al. requires the user to take extra steps to record both data entered by the telephone keypad and voice messages, such as pressing the "#" key, as required by Hashimoto et al. (see s20 in Fig. 5) illustrating the requirement of separate memories to store the DTMF data and the voice message data.

Moreover, even if it were obvious to modify Hashimoto et al. to incorporate the ICM and the memory as a single device, it would not be obvious to modify Hashimoto et al. to store "**combined messages**, which include the received audio messages of the text representation of the DTMF tones into the storage device," because Hashimoto et al. disclose only storing the digitized DTMF tones separately from the received audio messages and disclose the two types of messages as alternatives, not as being used together. The only suggestion to make these two modifications comes from Applicant's own disclosure. It is well settled that Applicant's disclosure can not be used against them in this manner.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.* (emphasis added)¹

Because Hashimoto et al. do not disclose or suggest these limitations of claim 1, claim 1 is not subject to rejection under 35 U.S.C. § 103 (a) as being obvious in view of Hashimoto et al.

¹ MPEP §706.02(j)

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Claims 3, 4 and 6 depend from claim 1 and are not subject to rejection under 35 U.S.C. § 103 (a) as being obvious in view of Hashimoto et al. for at least the same reasons as claim 1.

Claim 13, while not identical to claim 1, includes features similar to those set forth above with regard to claim 1. Thus claim 13 is also not subject to rejection for the reasons set forth above with regard to claim 1.

Claims 15, 16 and 18 depend from claim 13 and are not subject to rejection under 35 U.S.C. § 103 (a) as being obvious in view of Hashimoto et al. for at least the same reasons as claims 1 and 13.

Claims 2, 5, 14, and 17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of McNutt et al. This ground for rejection is respectfully traversed. First, McNutt does not provide the material that is missing from Hashimoto with regard to claims 1 and 13, as described above. McNutt et al. disclose a message taking and retrieval system which includes a central computer, operator stations for taking telephone messages and retrieval stations for permitting retrieval of messages either locally or via a telephone call. The messages for the caller are entered using a keyboard and forwarded to the central computer. McNutt et al. do not teach storing the **combined messages**, including audio messages and text representations of DTMF tones, as described above. Because neither Hashimoto, McNutt, nor their combination disclose or suggest the limitations of claims 1 and 13, claims 1 and 13 are not subject to rejection under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of McNutt et al. Claims 2 and 5 depend from claim 1 and claims 14 and 17 depend from claim 13. Thus, claims 2, 5, 14 and 17 are not subject to rejection under 35 U.S.C. § 103 (a) for at least the same reasons as claims 1 and 13.

Furthermore, with regard to claim 2, neither Hashimoto et al., McNutt et al., nor their combination disclose or suggest **"converting the text to speech signals**, wherein the processor stores the speech signals with the respective audio messages, corresponding to the text, **in the storage device."** (emphasis added). It would not have been obvious to convert the text to speech signals and then to store the converted text along with the audio messages

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into one storage device. Because neither Hashimoto, McNutt, nor their combination disclose or suggest the limitations of claim 2, claim 2 is not subject to rejection under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of McNutt et al.

Claim 14, while not identical to claim 2, includes features similar to those set forth above with regard to claim 2. Thus claim 14 is also not subject to rejection under 35 U.S.C. § 103(a) in view of Hashimoto et al. and McNutt et al. for the reasons set forth above with regard to claim 2.

Claims 7 and 12 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of Underkoffler. Hashimoto et al. is described above. Underkoffler concerns a telephone communications device for a hearing impaired person. Specifically, it describes an integrated circuit filter for separating DTMF tones into high and low frequency groups for concurrent presentation to a decoder. (See Abstract). It does not disclose or suggest storing **combined messages** including DTMF tones and voice messages into **the storage device**. Thus, Underkoffler does not provide the material that is missing from Hashimoto et al. Accordingly, claim 7 is not subject to rejection under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto et al. in view of Underkoffler.

Claim 12 depends from claim 7 and is not subject to rejection under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of Underkoffler for at least the same reasons as claim 7.

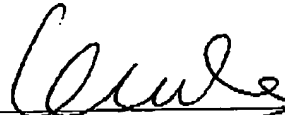
Claims 8, 9, 10 and 11 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of Underkoffler and McNutt et al. This ground for rejection is respectfully traversed. As set forth above, none of Hashimoto et al., Underkoffler nor McNutt et al. either alone or in combination discloses or suggests storing **combined messages** including DTMF tones and voice messages into **the storage device**, as required by claim 7. Claims 8, 9, 10 and 11 depend from claim 7 and are not subject to rejection under 35 U.S.C. § 103 (a) for at least the same reasons as claim 7. Because neither Hashimoto et al., Underkoffler, McNutt et al., nor their combination disclose or suggest the limitations of claim 7, claims 8, 9, 10 and 11 are not subject to rejection under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of Underkoffler and McNutt et al.

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In view of the foregoing amendments and remarks, Applicants request that the Examiner reconsider and withdraw the objection to the drawing and the rejection of claims 1-18.

Respectfully submitted,



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KNN/tmb

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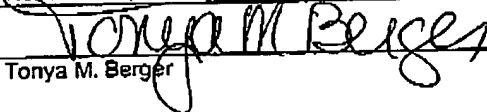
Attachments: Figure 2 (1 sheet)

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